

“A first solid surface” and “wherein the peptide of step (d) discriminates between the surfactant monolayer and the first geometric shape” is described in paragraph [0034], which describes a first surface that includes a surfactant. This paragraph also describes configuring the surface and surfactant so that the peptide binds to only the surfactant or the surface.

The first and second surfaces are described in paragraph [0028], which describes using multiple surfaces for the selection of peptides. Accordingly, the previous claim amendments are supported by the specification as filed.

Claims 1-7, 10-12, 15-19, and 32-36 stand rejected under 35 USC 112, first paragraph, as failing to comply with the written description. Specifically, the Examiner states on page 4 of the action that “the specification fails to provide an adequate written description for a method for identifying a peptide that binds to a surface having a target geometric shape. The disclosure does [sic] disclose any peptide that has been identified from a phage display library that binds to a target geometrical shape.” The Examiner’s rejection is contrary to clear case law, which states that neither examples nor a showing of actual reduction to practice is necessary to comply with the written description requirement. Specifically, in *Falkner v. Inglis*, 448 F.3d 1357, 1366 (Fed. Cir. 2006), the Federal circuit held:

Specifically, hold, in accordance with our prior case law, that (1) examples are not necessary to support the adequacy of a written description (2) the written description standard may be met (as it is here) even where actual reduction to practice of an invention is absent; and (3) there is no per se rule that an adequate written description of an invention that involves a biological macromolecule must contain a recitation of known structure.

As described in the response filed on December 28, 2005, the specification describes how to perform the claimed method, which is all that is necessary to comply with the written description requirement. Further, the fact that the specification does not disclose any specific peptide is irrelevant to written description of the method because applicants are not claiming any specific

peptide, they are only claiming methods for identifying peptides. Since the compositions and steps for performing the method are described in the specification, this rejection should be withdrawn.

Claims 1-7, 10-12, 15-19, and 32-36 stand rejected under 35 USC 112, first paragraph, as failing to comply with the enablement requirement. As previously explained in the response dated December 28, 2005, the Examiner has failed to make out a case for lack of enablement. Specifically, the Examiner has simply made broad assertions about the unpredictability of the art without providing any evidence to back up these assertions. Further, the specification is enabled because each of the process steps is based on well characterized/well established methodologies such that one of skill in the art could practice the invention as claimed.

In response to applicants arguments the Examiner states “. . . there is not objective enablement in the specification since not a single (desired) peptide has been enabled from the broad claimed method.” Again, in *Falkner v. Inglis*, 448 F.3d 1357, 1366 (Fed. Cir. 2006), the Federal Circuit, made it clear that neither the written description nor the enablement requirement requires that applicants provide any examples. Further, since applicants are not claiming a peptide, only a method of identifying a peptide, enablement of the peptide is irrelevant to the enablement of the claims.

Claims 1-7, 10-12, 15-19 and 32-36 stand rejected under 35 USC 103(a) as being unpatentable over any one of Naik, Belcher or Lee in view of Puentes and applicants' alleged admission of the known prior art.

The Examiner admits that Naik, Belcher and Lee fail to disclose a surface comprising a surfactant. However, the Examiner alleges it would have been “obvious to use a surfactant in the method of each of Naik or Belckher or Lee for the advantages taught by Puentes.” Further, the Examiner states that since self-assembled monolayer surfactants are known, it would be obvious to use this surfactant instead of the surfactants utilized in Puentes.

The Examiner's rejection is without merit. First of all, the Examiner states it would have been "obvious to use a surfactant in the method of each of Naik or Belckher or Lee for the advantages taught by Puentes." Puentes teaches the advantages of using a different type of surfactant than the claimed surfactant. Accordingly, Puentes does not provide any reason to use the claimed surfactant and actually teaches against using the claimed surfactant. Further, the fact that self-assembled monolayer surfactants are known does not mean that it would be obvious to use them in the claimed manner. As emphasized by the court in *In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002), the Examiner must present specific evidence of motivation to combine the reference on the record, not the generalized evidence relied on in the pending Action. Since the Examiner has failed to provide any motivation to utilize self-assembled monolayer surfactants in the claimed process, this rejection should be withdrawn.

In addition, the claims recite "wherein the peptide of step (d) discriminates between the surfactant monolayer and the first geometrical shape." The Examiner has failed to describe why it would be obvious from Naik, Belckher or Lee to utilize the surfactant in this claimed manner.

Accordingly, the rejection of claims 1-7, 10-12, 15-19 and 32-36 as being unpatentable over any one of Naik, Belcher or Lee in view of Puentes and applicants' alleged admission of the known prior art should be withdrawn.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark Office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection

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